UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 86824922

MARK: RHYTHM & HUES

86824922

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OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE:

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:

- Partial Section 2(d) Refusals—Likelihood of Confusion (3 Marks)
- Identification of Goods and Services
- Multiple—Class Application Requirements
- Information About Goods and Services Required

PARTIAL SECTION 2(D) REFUSALS—LIKELIHOOD OF CONFUSION (3 MARKS)

Registration of the applied-for mark is partially refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 3072409, 1906065, and 1939431. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.* , 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Applicant's mark is **RHYTHM & HUES**, presented in standard characters, for use in connection with " children's art; children's music; arranging, organizing, conducting and hosting children's birthday parties; retail store services."

Registration No. 3072409 is for the mark **RHYTHM & HUES**, presented in standard characters, for use in connection with "clothing and

accessories namely t-shirts, sweatshirts, caps" in International Class 25. **The refusal as to this mark applies ONLY to Applicant's "retail store services" services.**

Registration Nos. 1906065 and 1939431 are for the mark **RHYTHM & HUES**, presented in standard characters and with design, respectively, for use in connection with "entertainment services in the form of production and distribution of animation, special effects and computer graphics for motion pictures and television" in International Class 41. **The refusal as to this mark applies ONLY to Applicant's "children's art" and "children's music" goods/services.**

Similarity of the Marks (All Cited Registrations)

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

In the present case, applicant's mark is **RHYTHM & HUES** and the registrants' marks are **RHYTHM & HUES**. Thus, the parties' marks are identical in terms of appearance and sound. In addition, the connotation and commercial impression of the marks do not differ when considered in connection with Applicant's and the registrants' respective goods and/or services.

The examining attorney notes that the mark in U.S. Registration No. 1939431 contains stylization and design elements. However, these elements are entitled to minimal significance because Applicant's mark is presented in standard characters. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display").

Consequently, the parties' marks are confusingly similar.

Relatedness of the Goods and Services (U.S. Registration No. 3072409)

With respect to an applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified goods and/or services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Here, Applicant's pertinent services are broadly defined as "retail store services," with no restricts as to nature, type, channels of trade, or classes of purchasers. Such broad wording is therefore presumed to encompass retail store services of any and all kinds whatsoever, including those featuring clothing. Registrant's goods comprise clothing.

The attached evidence shows that clothing and retail store services featuring clothing may be provided by the same entities under a common source indicator, and that such goods and services travel in the same channels of trade to the same classes of purchasers.

Accordingly, the parties' pertinent goods and services are considered related for purposes of likelihood of confusion analysis.

Relatedness of the Services (U.S. Registration Nos. 1906065, and 1939431

With respect to an applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified goods and/or services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett*

Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

As an initial matter, the examining attorney notes that Applicant's "children's art" and "children's music" wording is not clearly identified as being a good or service. Accordingly, such wording must be presumed to encompass all goods that fall under these categories, as well as services for the production of such goods. Registrant's services comprise the production and distribution of animation, special effects, and computer graphics for motion pictures and television, with no restrictions as to type, channels of trade, or classes of purchasers. Accordingly, Registrant's services must be presumed to encompass the production of all variants of such works, including, for example, animations intended for children.

Accordingly, Applicant's "children's art" goods/services and Registrant's services are, as currently worded, overlapping in significant part. With respect to Applicant's music goods/services, the attached evidence shows that services for the production of animation and graphics and services for the production of music may be provided by the same entities under a common source indicator, and that such services travel in the same channels of trade to the same classes of purchasers.

Accordingly, the parties' pertinent services are considered related for purposes of likelihood of confusion analysis.

Conclusion

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Accordingly, since the parties' marks are similar and their pertinent goods and services related, registration of Applicant's mark must be partially refused under Trademark Act Section 2(d) due to a likelihood of confusion.

Applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below.

IDENTIFICATION OF GOODS AND SERVICES

The identification of goods and services contains indefinite and/or overly broad language that must be clarified and properly classified. TMEP § 1402.01.

Counsel for Applicant is politely reminded that, in the identification of goods and services, applicant must use the common commercial or generic names for the goods and services, be as complete and specific as possible, and avoid the use of indefinite words and phrases. TMEP §1402.03(a). Indefinite words for goods such as "accessories," "apparatus," "components," "devices," "equipment," "materials," "parts," "systems," or "products," must be followed by "namely" and a list of specific goods identified by their common commercial or generic names. *See* TMEP §§1401.05(d), 1402.03(a). Similarly, indefinite words for services such as "services in connection with," "such as," "including," "and like services," "concepts," or "not limited to," must be followed by "namely" and a list of specific services identified by their common commercial or generic names. *See* TMEP §1402.03(a).

That being said, the examining attorney shall discuss the specific deficiencies with Applicant's identification of goods/services below.

The wording **"children's art"** is indefinite and must be clarified because it fails to identify specific goods and services, and encompasses goods and services in multiple international classes. If this wording is intended to identify goods, then Applicant must follow it with "namely," followed by a list of specific children's art products that it intends to produce, and classify such goods accordingly. Works of art are generally classified by their material composition. For example, works of art made primarily of wood are in Class 20, whereas works of art made primarily of porcelain are in Class 21.

The wording **"children's music"** is indefinite and must be clarified because it fails to identify specific goods and services, and encompasses goods and services in multiple international classes. If this wording is intended to identify goods, then Applicant must state the medium on which the music is provided (i.e., "compact disc"), and classify the goods accordingly. For example, compact discs featuring children's music are in Class 9, whereas children's sheet music is in Class 16. If the music is provided online and is not downloadable, the provision of such music is considered a service in Class 41.

The wording **"retail store services"** is indefinite and must be clarified because it fails to identify specific services. Applicant must specify the field of the retail store services (i.e., "featuring clothing"), or state that the retail store services feature "a wide variety of consumer goods of others." If Applicant chooses the latter route, Applicant is advised in advance that when Applicant submits an amendment to allege use or

statement of use, Applicant will be required to provide one or more specimens showing that Applicant's retail store services ***do in fact feature*** a wide variety of consumer goods of others.

Applicant may adopt any or all of the following suggested wording, if accurate:

Class 9: compact discs featuring children's music;

Class 16: children's sheet music; works of children's art made of paper

Class 19: works of children's art made of clay

Class 20: works of children's art made of wood, wax, plaster or plastic

Class 35: retail store services featuring {specify one or more fields of the retail store services, i.e., "works of art"}

Class 41: providing non-downloadable prerecorded music online via a global computer network; arranging, organizing, conducting and hosting children's birthday parties

An applicant may only amend an identification to clarify or limit the goods and/or services, but not to add to or broaden the scope of the goods and/or services. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07.

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at http://tess2.uspto.gov/netahtml/tidm.html. *See* TMEP §1402.04.

MULTIPLE-CLASS APPLICATION REQUIREMENTS

The application identifies goods and/or services in more than one international class; therefore, applicant must satisfy all the requirements below for each international class based on Trademark Act Section 1(b):

(1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class.

(2) **Submit a filing fee for each international class** not covered by the fee(s) already paid (view the USPTO's current fee schedule at http://www.uspto.gov/trademarks/tm_fee_info.jsp). The application identifies goods and/or services that are classified in at least 6 classes; however, applicant submitted a fee sufficient for only 1 class. Applicant must either submit the filing fees for the classes not covered by the submitted fees or restrict the application to the number of classes covered by the fees already paid.

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.32(a)(6)-(7), 2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(b) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, please go to http://www.uspto.gov/trademarks/law/multiclass.jsp.

The fees for adding classes to a regular TEAS application are $325 per class when the fee is paid using the Trademark Electronic Application System (TEAS) and $375 per class when the fee is paid in a paper submission. *See* 37 C.F.R. §2.6(a)(1)(i)-(ii); TMEP §§810, 1403.02(c).

INFORMATION ABOUT GOODS AND SERVICES REQUIRED

To permit proper examination of the application, applicant must submit additional information about the goods and services. *See* 37 C.F.R. §2.61(b); *In re AOP LLC*, 107 USPQ2d 1644, 1650-51 (TTAB 2013); *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004); TMEP §814. The requested information should include fact sheets, instruction manuals, brochures, and/or advertisements. If these materials are unavailable, applicant should submit similar documentation for goods and services of the same type, explaining how its own product or services will differ. If the goods and services feature new technology and no information regarding competing goods and services is available, applicant must provide a detailed factual description of the goods and services.

Factual information about the goods must make clear how they operate, salient features, and prospective customers and channels of trade. For the services, the factual information must make clear what the services are and how they are rendered, salient features, and prospective customers and channels of trade. Conclusory statements will not satisfy this requirement for information.

Failure to comply with a request for information can be grounds for refusing registration. *In re AOP LLC*, 107 USPQ2d at 1651; *In re DTI P'ship LLP*, 67 USPQ2d at 1701-02; TMEP §814. Merely stating that information about the goods and services is available on applicant's website is an inappropriate response to a request for additional information and is insufficient to make the relevant information of record. *See In*

re Planalytics, Inc., 70 USPQ2d at 1457-58.

RESPONSE GUIDELINES

For this application to proceed toward registration, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements.

If applicant does not respond to this Office action within six months of the issue/mailing date, or responds by expressly abandoning the application, the application process will end, the trademark will fail to register, and the application fee will not be refunded. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a), 2.209(a); TMEP §§405.04, 718.01, 718.02. Where the application has been abandoned for failure to respond to an Office action, applicant's only option would be to file a timely petition to revive the application, which, if granted, would allow the application to return to active status. *See* 37 C.F.R. §2.66; TMEP §1714. There is a $100 fee for such petitions. *See* 37 C.F.R. §§2.6, 2.66(b)(1).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

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All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

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